

## REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed March 24, 2004.

Currently, Claims 1-9 are pending. Applicant respectfully requests reconsideration of Claims 1-9.

### A. The Johnson References as Prior Art

The Examiner has based the rejection on two references to Johnson, which in turn claim priority to two earlier references to Johnson. For ease of convention, the following will be used to refer to the various Johnson references:

- Johnson I - Publication No. US 2001/0047471, forming the basis of the rejection of claims 1, 6 and 8 under §102(e);
- Johnson II - Publication No. US 2002/0016912, forming part of the basis of the rejection of Claims 2-5, 7 and 9 under §103(a);
- Johnson III - U.S. Patent No. 6,499,108, of which Johnson I and Johnson II are continuation-in-part applications;
- Johnson IV - U.S. Patent No. 5,970,149, of which Johnson I and Johnson II are continuation-in-part applications.

In applicant's prior Response to Office action, applicant argued that the earlier Johnson references, Johnson III and Johnson IV, did not provide adequate support for the disclosures of the cited references, Johnson I and Johnson II, to allow the priority date of the cited references to be carried back. In traversing applicant's arguments, in the current Office action, the Examiner has stated:

[Johnson III and IV] disclose the same concept [as Johnson I and II] of a base device with a secure agent system operating within to secure communicating data associated with the base device..., the base device configured to be coupled with a remote access system.

Thus, the Examiner concluded that Johnson III and IV have proper support for the subject matter.

Applicant respectfully submits that the Examiner has applied and incorrect standard with regard to when a CIP may benefit from the filing date of the parent as a prior art reference under §§102(e) and 120. In a chain of continuation-in-part applications, the date of a parent application can be relied upon under §120 as a reference with respect to a particular feature *if and only if* that particular feature is disclosed in the parent application. *In re Wertheim*, 646 F.2d 527 (CCPA 1981); *In re Smith*, 458 F.2d 1389 (CCPA 1972). To support a rejection under section 102, the Examiner has the burden of showing that each of the claimed features is found in a single prior art reference that was filed at least as early as the claimed invention. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 1363 (Fed. Cir. 1998). Omission of any claimed element, no matter how insubstantial, is grounds for traversing a rejection based on §102. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983). Therefore, to support the rejection, the Examiner must show that each of the claimed features is disclosed within a reference in existence at the time the present application was filed.

There are several features of the claimed invention which are nowhere disclosed in either Johnson III or Johnson IV, nor has the Examiner indicated that these features are shown in Johnson III or IV. Without such a showing by the Examiner, Johnson III and Johnson IV may not be relied upon as support for the rejection. For example, at least the following express claim elements are not found in either Johnson III or Johnson IV:

- a job handler module operatively coupled to said server communication module, said job handler configured to retrieve, store, update and delete data associated with the base device (Claims 1-5);
- retrieving, storing, updating and deleting data associated with the base device according to commands received by the base device from the remote access system (Claims 6-9).

As set forth below, applicant respectfully submits that these features are not shown in Johnson I or Johnson II either. However, whether or not Johnson I or II shows these features is immaterial, as Johnson I and II were filed after the filing date of the present application and therefore by themselves are not prior art. The scope of prior art may only include references filed prior to the filing date of the instant application. While Johnson III and Johnson IV fall within this scope, those references do not disclose the limitations of the claimed invention.

The Examiner appears to appreciate this. If Johnson III or Johnson IV showed each

feature of the claimed invention, then Johnson III and/or Johnson IV would have formed the basis of the rejection. However, the Examiner appears to understand that Johnson III and IV do not disclose all of the claim elements and therefore, could not form the basis of the rejection. Instead, the Examiner attempts to circumvent this requirement by stating that Johnson I and II show the claim limitations, and then saying Johnson I and II are entitled to the Johnson III and IV filing dates with respect to those claim limitations. This is impermissible unless the Johnson III and IV references also disclose those claim limitations. As discussed above, they do not.

Based on the above, it is respectfully submitted that Johnson I and Johnson II are not prior art to the present invention, and while Johnson III and Johnson IV are prior art, they do not disclose the claimed invention. If the Examiner maintains the rejection, it is respectfully requested that the Examiner specifically point out the basis for disregarding the requirements of §§102 and 120, or that the Examiner specifically point out where each of the claim limitations are found in Johnson III or Johnson IV.

B. Request For Withdrawal of Finality of the Office Action

As set forth above, it is respectfully submitted that the Examiner has not established a *prima facie* rejection with respect to the claimed invention, either in the present Office Action or the previous Office Action. It is therefore respectfully requested that the finality of the Office Action be withdrawn so that the claims may be reconsidered in view of the scope of the prior art which applies to the claimed invention.

C. Response to Examiner's Specific Grounds for Rejection

In the Office action, the Examiner has rejected Claims 1, 6 and 8 under §102(e) over Johnson I, stating in part:

Johnson does not specifically disclose retrieving, storing, updating and deleting data. However, these processes are inherent in "transference of data associated therewith" of ([0047], lines 13-15).

Applicant respectfully submits that the Examiner has applied an incorrect standard to inherency or meaning to the language said to inherently show the claimed limitations. Where a reference is alleged to inherently disclose a claim element, the missing element must necessarily

be present in the cited reference and that it be so recognized by those of skill in the art. It is not enough that the missing element is possibly or probably present. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

The alleged support set forth by the Examiner for the claim limitations is as follows:

As used herein, the term "adaptor" refers synonymously to those hardware configurations such as, but not limited to, "adaptor cards" which allow for connectability between two or more central processing units and the transference of data associated therewith.

The phrase "transference of data associated therewith" implies no more than the adaptor allows for transfer of data between two or more central processing units. There is no disclosure whatsoever at that section that:

- the transference of data must include the storing of data;
- the transference of data must include the updating of data;
- the transference of data must include the deleting of data.

As these features are not necessarily part of the transference of data, these features cannot be considered inherent as that principal applies to §102.

As indicated above, Johnson I cannot be considered prior art to the present invention. Moreover, Johnson I fails to disclose the features recited in Claims 1, 6 and 8. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Claims 2-5, 7 and 9 were rejected under §103 over Johnson I in view of Johnson II. As stated above, it is respectfully submitted that Johnson I and Johnson II are not prior art to the present invention. Moreover, Claims 2-5, 7 and 9 each depend directly or indirectly on Claims 1, 6 and 8, and are therefore patentable over the cited references for the reasons set forth above with respect to Claims 1, 6 and 8.

Based on the above amendments and these remarks, reconsideration of claims 1-9 is respectfully requested.

The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, June 24, 2004.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date:

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